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| APPLICATION NO.  | FILED DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|------------|----------------------|---------------------|------------------|
| 09/710,162   | 11/10/2000 | Richard M. Onyon     | FUSN 1-01008US0     | 4588             |
| 28554  | 7590       | 06/09/2004           | EXAMINER            |                  |
| VIERRA MAGEN MARCUS HARMON & DENIRO LLP<br>685 MARKET STREET, SUITE 540<br>SAN FRANCISCO, CA 94105 |            |                      | PATEL, HARESH N     |                  |
|  |            | ART UNIT             |                     | PAPER NUMBER     |
|  |            | 2154                 |                     |                  |
| DATE MAILED: 06/09/2004  |            |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/710,162             | ONYON ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Haresh Patel           | 2154                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 November 2000.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-26 and 34-37 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 27-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5 and 7.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-37 are presented for examination.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 27-33, are drawn to “a personal information space transferring media data to a network coupled apparatus”, classified in class 709, subclass 217.
- II. Claims 11-19, are drawn to “determination of digital media data synchronization among devices”, classified in class 709, subclass 248.
- III. Claims 23-26, 34-37, are drawn to “an agent adding, deleting or modifying private digital media information of the information server”, classified in class 709, subclass 202.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as lacking “determination of digital media data synchronization among devices”, particulars. Invention II has separate utility such as lacking “an agent adding, deleting or modifying private digital media information of the information server”, particulars. See MPEP 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the extensive search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
7. A telephone call was made to Larry E Vierra on June 4, 2004 to request an oral election to the above restriction requirement. Larry E Vierra elected invention I (Claims 1-10, 27-33) without traverse.
8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
9. Claims 11-26, 34-37, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups II and III, there being no allowable generic or

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linking claim. Applicant is requested to cancel the claims 11-26, 34-37. Examiner examines the applicant's elected invention I (Claims 1-10, 27-33).

***Specification***

10. The disclosure is objected. Some of the informalities are:

- i. The section "CROSS-REFERENCE TO RELATED APPLICATIONS" is missing co-pending applications and related arts.

11. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The present title is not sufficient for proper classification of the claimed subject matter.

12. The abstract is objected. Some of the informalities are:

- a. The abstract should contain only one paragraph.
- b. The abstract does not contain key components of the invention.
- c. The abstract should clearly state the goal of the invention, rather containing claim language.

Correction is required. See MPEP § 608.01(b).

***Information Disclosure Statement***

13. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 5 and 7, is attached to the instant Office action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 4 and 6, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
15. Claim 4, recites the limitation "said automotive computer". There is insufficient antecedent basis for this limitation in the claim.
16. Claim 6, recites the limitation "the digital media". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-10, 27-33, are rejected under 35 U.S.C. 102(e) as being anticipated by Hertzog et al. US 2003/0069874 A1, April 10, 2003 (Hereinafter Hertzog).

19. As per claims 1 and 27, Herzog teaches the following:

a system/method for transferring digital media between a plurality of network coupled devices (e.g., a system to synchronize personal information including digital photograph information, among network connected devices, figure 1, abstract), comprising:

maintaining a personal information space identified with a user including media data (e.g., server farm containing personal information including digital photograph information, figure 1, abstract), the personal information space being coupled to a network (e.g., server farm containing servers connected to the network, figure 1);

transferring at least a portion of the media data from the personal information space to the network coupled apparatus in a differencing transaction in response to a user request (e.g., use of PDA by a user to synchronize digital multimedia data with personal information contained in the server of the server farm, col., 3, paragraphs 42 – 49),

a personal information store containing digital multimedia data (e.g., server farm containing server with user specific digital photograph information, col., 3, paragraphs 42 – 49),

a data transfer request initiator coupled to the personal information store (e.g., service module to handle user specific information, col., 3, paragraphs 42 – 49), and

a device engine operatively coupled to the data transfer request initiator and responsive to the initiator to transfer digital media between the store and one of said plurality of network coupled devices (e.g., service module, synchronization engine responsible for synchronizing information maintained in the local database with information maintained on a remote database accessible via the network, col., 3, paragraph 46).

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20. As per claims 2-10, 28-33, Herzog teaches the following:

the step, prior to step (a), of receiving information into the personal information space (e.g., receiving of digital multimedia data for synchronization, figure 1, col., 3, paragraphs 42 – 49),

the step of receiving comprises receiving data from a first network coupled apparatus (e.g., receiving data from a desired network connected device, figure 1, col., 3, paragraphs 42 – 49), and said step (b) includes transferring said media data to a second network coupled apparatus (e.g., transferring of digital multimedia data to a user desired network connected device, figure 1, col., 3, paragraphs 42 – 49),

the step, following step (a), of identifying the private information space associated with the user by prompting a user login from said automotive computer and retrieving login information input by the user (e.g., use of authentication mechanism, col., 5, paragraph 64),

step (b) comprises transferring said at least a portion of media data in the form of a plurality of differencing transactions (e.g., synchronization performed for multimedia data using multiple sequencing transactions, figure 1, col., 3, paragraphs 42 – 49),

the digital media comprises a directory of digital media files (e.g., list of multimedia files, figure 1, col., 3, paragraphs 42 – 49),

said step (a) comprises providing a storage server having a network connection (e.g., a server of server farm connected to the internet, figure 1), and code on the storage server interacting with the personal information space (e.g., service module, col., 3, paragraphs 42 – 49); and the method further includes the step, prior to said step (b), of:

generating at least a first differencing transaction comprising at least a portion of said media data to be transferred in said step (b) (e.g., synchronization performed for multimedia data using multiple sequencing transactions, figure 1, col., 3, paragraphs 42 – 49),

(c) providing code on a network-coupled apparatus which receives said at least portion of the media data and stores the media data on the network-coupled apparatus (e.g., client using PDA, etc devices, figure 1, col., 3, paragraphs 42 – 49),

instantiating code on a network-coupled server storing said personal information space to output the media data to the network-coupled apparatus (e.g., use of service module to provide digital multimedia data to the client, figure 1, col., 3, paragraphs 42 – 49),

instantiating code on the network-coupled apparatus to retrieve the media data (e.g., use of service module to provide digital multimedia data to the client, figure 1, col., 3, paragraphs 42 – 49),

the personal information store is provided on a server (e.g., server of server farm, figure 1),

the server is coupled to the Internet (e.g., server connected to internet, col., 1, paragraph 2),

the server includes at least a portion of the device engine (e.g., service module of server, figure 1, col., 3, paragraphs 42 – 49),

the device engine is provided on a server which includes at least a portion of the personal information store (e.g., service module of server of the server farm, figure 1, col., 3, paragraphs 42 – 49),

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the data transfer request initiator is provided on said at least one of said plurality of network-coupled devices and comprises code on said one of said plurality of network-coupled devices to operatively engage the device engine to transfer digital media between the store and the one of the plurality of network-coupled devices (e.g., service module of server of the server farm and service module of client device to synchronize digital multimedia data among personal information spaces, figure 1, col., 3, paragraphs 42 – 49).

*Conclusion*

21. Examiner makes a very clear note that the rational of the applicant's invention has been clearly taught by the cited reference. Applicant's invention does contain few minor additional matters that facilitate the concepts of the applicant's invention. However, the additional minor matters are well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

June 6, 2004.



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